

## **REMARKS**

### **I. Status and Disposition of the Claims**

In the instant application, claims 1-36, of which claims 1, 7, 12, 16, 21, 24, 26, 30 and 33 are independent, are pending and under consideration on the merits.

In the Final Office Action<sup>1</sup> mailed October 7, 2008, the following actions were taken:

1) claims 1-5, 7-11, and 26-29 were rejected under 35 U.S.C. §101 for failing to qualify as a patent eligible process; and

2) claims 1-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pat. No. US 4,773,009, by Kucera et al. (herein after "*Kucera*") in view of Pat. No. US 7,343,308, by Rojewski et al. (herein after "*Rojewski*").

### **II. Amendments to the Claims**

In this Amendment and Response to the Office Action, Applicant amends claims 1-12, 16, 21, 24, 26-30 and 33. Support for amendments to claims 1-11 and 26-29 are found at page 1, para. [002] of the Specification, "This invention relates to ... methods for processing data associated with insurance claims using a computer," and page 7, para [028] of the Specification, "Figure 2 is a block diagram of... various software components that may be stored in memory 104." Also, support for the amendments to claims 1, 7, 12, 16, 21, 24, 26-30 and 33 are found at page 10, para. [036] of the

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Specification, "Non-sentence textual groupings may be, for example, data fields from a claim form.... Because such information may not be in traditional sentence form, sentence splitter 304 may separate the information in each data field and group the information with a heading of the data field."

Applicant added new claim 37. No new matter has been introduced.

### **III. Response to Rejections**

In this Response to the Office Action, Applicant respectfully traverses the rejection listed above.

#### **A. The Rejection of the Claims under 35 U.S.C. §101 is Improper.**

Claims 1-5, 7-11, and 26-29 are rejected under §101 for failing to qualify as a patent eligible process. See Office Action at 2. The Office Action asserts that independent claims 1, 7 and 26 are directed towards a method of processing insurance claims, but "not tied to any particular apparatus for which to process the insurance claims thus recites purely mental steps." *Id.* Applicant disagrees with this assertion.

However, to further prosecution, Applicant amended the claims to call for a "computer-implemented method" and "the computer-implemented methods of." Moreover, the instant claims present a number of software components, such a text analyzer, rules engine, a processor, and a number of modules, such as analyzing module, assigning module and determining module. The Board of Patent Appeals and Interfaces in *Ex parte Bo Li* has found this combination statutory under the teachings of *In re Lowry*, 32 F.3d 1579 (Fed. Cir., 1994). *Ex Parte Bo Li*, Appel 2008-1213 at 9

(BPAI 2008). Further, this combination is in accordance with *In re Bilski*, Case 2007-1130 (Fed. Cir., Oct 30, 2008). In view of the totality of these precedents and currently presented amendments, Applicant requests the rejection under 35 U.S.C. §101 to be withdrawn.

**B. The Rejection of the Claims under 35 U.S.C. §103 is Improper.**

Applicant respectfully traverses the rejection of claims 1-36 under 35 U.S.C. §103(a) as being unpatentable, because a *prima facie* case of obviousness has not been established. "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis." M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

#### **1. Claims 1-36 are allowable.**

Claims 1-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kucera* in view of *Rojewski*. See Office Action at page 3. Applicant respectfully disagrees and traverses the rejection for at least the reasons stated below.

As discussed in detail below, a fair reading of *Kucera* and *Rojewski* reveal that the references fail to teach or suggest each and every element of amended claim 1, nor do they teach amended independent claim 1 as a whole. In the present case, amended independent claim 1 recites, *inter alia*,

- analyzing **text associated with an insurance claim** by a text analyzer to extract **data elements of the insurance claim related to the insurance claim's**

**subrogation potential**, the text comprising at least one of the following: sentence textual groups and **non-sentence textual groups**. (Emphasis added).

*Kucera* does not teach, disclose or suggest the above cited element. The Office Action confirms this partially by asserting, "*Kucera* does not expressly teach the text is associated with an insurance claim to extract data elements related to the insurance claim's subrogation potential...." See Office Action at 3.

Further, *Kucera* does not teach, disclose, or suggest "analyzing . . . non-sentence textual groups." Moreover, the method and system disclosed in *Kucera* is silent about the capabilities of analyzing non-sentence textual groups. *Kucera* provides a text editing system capable of accurately and reliably breaking down a block of digitally encoded text by analyzing sequential strings thereof to determine paragraph and sentence boundaries. See *Kucera*'s Abstract and col. 2, line 32-35. This is different than the present Application, wherein analyzing non-sentence textual groups such as data fields from a claim form includes separating the information in each data field and group the information with a heading of the data field. See Specification at para. [036]. As support for its rejection of claim 4, the Office Action cites *Kucera*'s col. 9, line 43 to col. 10, line 8 as teaching non-sentence groupings. Applicant does not agree with this assertion.

*Kucera*'s col. 9, line 43 to col. 10, line 8 refers to *Kucera*'s Fig. 6, illustrating a detailed flow chart of the syllable counter portion of its system. *Kucera* looks up each word in a table of common words, called a "modified Dale-Chall list," to identify the empirical syllable count. See *Kucera* at col. 9, lines 31-37. Thus, *Kucera* identifies the syllables in words, not "non-sentence textual groups." Nowhere in this citation or

elsewhere in *Kucera* is there a suggestion of "non-sentence textual groups" or "analyzing text... comprising... non-sentence textual groups." Therefore, nowhere in *Kucera* is there a suggestion of a method for "analyzing... non-sentence textual groups," as recited in amended claim 1.

*Rojewski* fails to cure the deficiencies of *Kucera*. That is, *Rojewski* also fails to teach, disclose or suggest amended claim 1, namely, "analyzing text..., the text comprising at least one of the following: sentence textual groups and non-sentence textual groups." Nowhere in *Rojewski* is there a mention of a text analyzer let alone "analyzing... non-sentence textual groups."

Because neither *Kucera* nor *Rojewski* disclose "analyzing text associated with an insurance claim by a text analyzer to extract data elements of the insurance claim related to the insurance claim's subrogation potential, the text comprising at least one of the following: sentence textual groups and non-sentence textual groups," as recited in amended claim 1, the cited references fail to teach or suggest each and every element of claim 1.

Moreover, one of ordinary skill in the art would not find it obvious to modify the system of *Kucera*, using teachings of *Rojewski*, to achieve the required combination recited by claim 1. As noted above, Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide some concrete evidence** in the record in support of findings.

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify *Kucera*, using the teachings of *Rojewski*, so as to arrive at the claimed invention. In particular, the Office Action does not explain at

least: (a) *why* one of ordinary skill would use the teachings of *Rojewski*, which does not even include a mention of an analyzer, to modify its analyzing steps to analyze non-sentence textual groups, and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Kucera* and *Rojewski* so as to arrive at the above-recited feature of amended claim 1.

The burden is on the Patent Office to provide some tenable rationale as to *why* and *how* one of ordinary skill in the art would combine *Kucera* and *Rojewski* and the known art so as to arrive at the presently claimed methods recited in claim 1. This has not been provided.

At best, the position taken in the Office Action could be considered an assertion that the proposed modifications could be performed. However, “[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01 (emphasis in original). Combining *Kucera* and *Rojewski* would not result in a predictable variation of Applicant’s invention, which, at minimum, would require all of the elements recited in amended claim 1. Since a hypothetical *Kucera* and *Rojewski* combination would lack the elements recited in amended claim 1, namely “analyzing text associated with an insurance claim..., the text comprising at least one of the following: sentence textual groups and non-sentence textual groups,” the *Kucera* / *Rojewski* combination would not be a predictable variation.

Further, even assuming *arguendo* that the assertion is correct that *Kucera* discloses non-sentence textual groups and that combining *Kucera* and *Rojewski* somehow allows using “text comprising... sentence textual groups and non-sentence

textual groups" as an input, the combination would miss the objective of the Applicant's recited method and system. Neither reference teaches how to analyze the non-sentence textual groups, so neither reference would suggest what to do with such text if provided. Therefore, a hypothetical *Kucera / Rojewski* combination would miss the objective of the Applicant's method, which recites "analyzing text associated with an insurance claim..., the text comprising at least one of the following: sentence textual groups and non-sentence textual groups."

For at least this reason, Applicant submits that the Office has not met the burdens necessary to establish that amended claim 1 is obvious under § 103(a). Therefore the § 103(a) rejection of amended claim 1 is improper, and should be withdrawn.

For at least the reasons noted above, claims 7, 12, 16, 21, 24, 26, 30 and 33 which recite similar elements and were rejected under the same rationale, and claims 2-6, 8-11, 13-15, 17-20, 22-23, 25, 27-29, 31-32 and 34-36 which depend directly or indirectly from claims 1, 7, 12, 16, 21, 24, 26, 30 and 33 are allowable under 35 U.S.C. 103(a).

#### **IV. Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.



Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated:

12-23-08

By:



Maura K. Moran  
Reg. No. 31,859